



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|-------------------------------|
| 10/684,624 | 10/14/2003 | Susanne Knop | 2002DE138 | 3761 |
| 7590 | 05/20/2005 | | EXAMINER | |
| Clariant Corporation Industrial Property Department 4000 Monroe Road Charlotte, NC 28205 | | | | COONEY, JOHN M |
| | | | | ART UNIT 1711 PAPER NUMBER |

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/684,624 | KNOP ET AL. | |
| | Examiner | Art Unit | |
| | John m. Cooney | 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 February 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0305.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

Applicant's arguments filed 2-22-05 have been fully considered but they are not persuasive.

The following rejections are maintained:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Eilbracht et al.(6,380,273).

Eilbracht et al. discloses preparations of flexible polyurethane foams prepared with the combination of the hydroxyalkyl phosphonates claimed in combination with additional known flame retardants as desired (see abstract, column 1 lines 25-40, column 2 line 43 – column 6 line 59, as well as the entire document). Eilbracht et al.'s own teaching recognizes the usefulness of applicants' claimed additional flame retardants, and teaches other flame retardants to be employable in their formulations. The teaching is held to be anticipatory of these combinations of fire retarding agents.

Further, the disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. *In re Nehrenberg* 126 USPQ 383.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by DE-199 27 548 A1.

DE-199 27 548 A1 discloses preparations of flexible polyurethane foams prepared with the combination of the flame retardants as claimed (see the entire document).

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Shim (3,989,652).

Shim discloses preparations of polyurethane foams prepared with the combination of the hydroxyalkyl phosphonates claimed in combination with additional known flame retardants as desired (see abstract, column 2 lines 56 – column 7 line 62, as well as the entire document). Shim's own teaching recognizes the usefulness of additional flame retardants to be employable in their formulations. The teaching is held to be anticipatory of these combinations of fire retarding agents as the additional halogenated flame retardants of applicants' claims are held to be readily envisioned from the teachings of Shim's disclosure.

The following is set forth as an alternative rejection and is to be addressed and treated separately from the above rejections under 35 USC 102:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shim in view of Sicken (5,728,746).

Shim discloses preparations of polyurethane foams prepared with the combination of the hydroxyalkyl phosphonates claimed in combination with additional known flame retardants as desired (see abstract, column 2 lines 56 – column 7 line 62, as well as the entire document). Shim's own teaching recognizes the usefulness of additional flame retardants to be employable in their formulations. Shim differs in that it does not specifically recite the chlorinated phosphoric esters of applicants' claims in its recitations of known flame retardants. However, Sicken discloses that halogenated phosphoric esters as claimed by applicants are useful in the urethane arts for the purpose of imparting flame retardancy (see column 1 line 31-42). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the flame retardants of Sicken in the preparations of Shim for the purpose of imparting their flame retarding effect in the formulations of Shim in order to arrive at the products and

processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' arguments with regards to the rejections under 35 USC 102 have been considered, but the rejections are maintained for the reasons set forth above. The feature of improved ageing resistance is a feature which is seen to be an inherent result owing to the similarities in the materials involved in the preparations of the instant concern.

Applicants' arguments regarding the alternative rejection under 35 USC 103 over Shim in view of Sicken have been considered, but rejection is maintained for the reasons set forth above. Notwithstanding the issues of inherency in the paramount rejection under 35 USC 102 over Shim, applicants' have not established a showing of new or unexpected results attributable to their combinations of materials in the preparation methods as claimed which are commensurate in scope with the scope of the claims as they currently stand.

The following rejection is set forth in light of the IDS submitted 3-11-05:

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by DE-1812165.

DE-1812165 discloses preparations of flexible polyurethane foams prepared with the combination of the flame retardants as claimed (see the entire document).

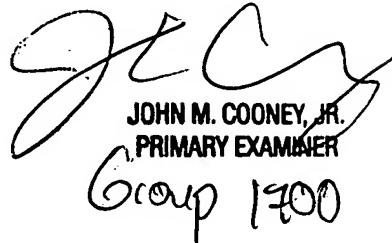
Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 3-11-05 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700